

REMARKS

Claims 1-24, 26-31 are pending in the present application. Claim 25 is cancelled. Claims 27-31 are new.

I. New Claims

Claim 27-31 have been added to more fully claim the subject matter disclosed in the specification of the present application..

II. Claim Rejections Under 35 U.S.C. 102(b)

Claims 1-5, 8, 10-15, 26 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,759,101 to Von Kohorn ("Von Kohorn".) Applicant respectfully traverses.

The invention claimed in independent Claim 1 is directed to a method of conducting an incentivized trivia contest to increase the effectiveness of advertising. A first set of trivia questions relating to advertising content are stored in a computer system. A second set of trivia questions relating to show content are additionally stored in the computer system. The first and second sets of trivia questions are associated with a broadcast of the advertising content along with the show content. A subset of the first set of trivia questions and a subset of the second set of trivia questions are selected to ask a member. The subsets of questions are transmitted the said member and member's responses are received via a communication medium. The member's performance in response to the subsets of trivia questions are scored. Incentives are provided to the member based upon the results of the scoring.

Independent claim 12 is directed to a method of using a user's demographic profile to conduct a trivia contest using such first and second sets of questions. Independent claim 14 is directed to a method of determining advertising performance using such first and second sets of questions. Independent claim 15 is directed to a method of determining the effectiveness of product placement based upon members' answers to first and second subsets of questions. Independent claim 16 is directed to a method of creating a report indicative of the effectiveness of advertising content using such first and second sets of questions. Independent claim 20 is directed to a method of increasing the effectiveness of advertising content, determining

advertising content performance, and determining show content performance, using such first and second sets of questions. Independent claim 21 is directed to a method of creating a report indicative of recall, understanding, likeability or other broadcast performance measure, using such first and second sets of questions.

Von Kohorn discloses a system which allows external participants to participate in a broadcast, e.g., a television show. An instructional signal is modulated onto a signal transmitted concurrently with the television program, simulcast, or time-multiplexed with a television. At each of a plurality of remote receiving stations, one or more members of a remote audience have the opportunity to respond to a situation presented in the television program by entering a response on a keyboard. The program may be presented live conducted by a host at a central station, or by a prerecorded message accessible by telephone from a remote station with regulation from a central station.

Independent claims 1, 12, 14-16, and 20-21 all contain limitations to the effect that trivia questions are stored on a computer. As has been previously argued, Von Kohorn does not teach or suggest storing any questions in a computer. While Von Kohorn col. 2, lines 52-55, states “questions or similar tasks... may be recorded prior to transmission”, there is no suggestion that the recording means is a computer. In fact, within the disclosure of Von Kohorn, where means for recording questions is discussed in detail, it is apparent the storage means is not a computer. For example, Von Kohorn, col. 5, lines 29-30 refers to “playback of an audio-visual tape.”

To the extent Von Kohorn teaches recording responses to see if a response matches correct answers to a question, there is no logical necessity that the questions themselves must be stored to enable the system to determine if the answers correspond to the questions being asked. For example, the correct response to a question may simply be stored with a reference number, such as, for example, a question number. To the extent that Von Kohorn teaches displaying questions on electronics boards, there is no logical necessity that the questions must be stored on a computer or on any other storage device, for that matter. For example, the questions could be typed in from a keyboard connected to an electronics board.

The Examiner’s assertion that “questions must be read from somewhere” is legally insufficient to make out an argument that questions are stored on a computer. There is, in fact,

no explicit reference to storing questions on a computer. Rather, the Examiner attempts to infer, based on disclosed functionality that, somehow, questions must be stored on a computer. As discussed above, the Examiner's inferences are flawed and amount to speculation at best. Invalidity by anticipation requires that the four corners of a single, prior art document describe every element of the claimed invention. Studiengesellschaft Kohle, m.b. H. v. Dart Indus., Inc., 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984). Where conflicting theories can be deduced from a document, the document is too indefinite to be utilized as an anticipation. Anchor Plastics Co. v. Dynex Indus. Plastics, Corp., 363 F. Supp. 582, 588, 179 USPQ 264 (D. N.J. 1973) , aff'd, 492 F.2d 1238 (3d Cir. 1974).

Independent Claims 1, 12, 14-16, and 20 all contain limitations to the effect a first set of trivia questions relating to advertising content and a second set of trivia questions relating to show content are stored on a computer. As has been previously argued, Von Kohorn does not teach or suggest storing questions in a computer, or on any device, for that matter, divided into first and second sets of questions relating to show content and advertising content, respectively. While Von Kohorn discloses that questions may relate to show content, Von Kohorn col. 2, lines 42-59, or to television advertisements or "commercials", Von Kohorn col. 44, lines 55 to col. 45, lines 1-5, there is no act described of storing the questions in sets. At most, Von Kohorn describes scenarios where all of the questions pertaining to a broadcast are recorded as a unit on a audio-visual tape.

Von Kohorn does not disclose selecting a subset of said first set of trivia questions and a subset of said second set of trivia questions to ask a member. Von Kohorn, col. 16, line 30-39 mentions that the system may implement, "multipart questions". Von Kohorn's definition is reproduced below verbatim for ease of reference:

The terms "multipart task" or "multipart question" are intended to include any situations, such as questions, tasks and puzzles, in which a contestant is required to provide chronologically spaced responses related to a common question, task, puzzle, or subject matter requiring an action by the contestant. Such a task may include so-called umbrella or omnibus questions comprising sub-groups, contingent questions (e.g. "if the answer is "true", then proceed to . . .) and sub-questions derived from a parent question.

To the extent a question may have multiple parts does not, however, represent the selection of a subset of questions from a larger set of questions. Rather, it is merely a type of question. To the extent Von Kohorn, FIG. 28, 840, refers to a shopper's selection of an area of interest (i.e. product), there is nothing in the disclosure to indicate such an action causes the selection of two subsets of questions relating to show content and advertising content respectively. Von Kohorn, col 89, line 5-10 merely holds "The shopper selects an area of interest at block 840 at the response unit, and then enters a response at block 842. Upon a successful responding, the respondent shopper receives at block 844 a coupon from the response unit. The coupon provides a discount for selected products, and may carry advertising."

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053, 814 F.2d 628, 631 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. Richardson v. Suzuki Motor Co., 9 USPQ2d 1913,1920, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Since, as argued above, independent Claims 1, 12, 15, and 16 contains elements neither expressly or inherently described in Von Kohorn, Claims 1, 12, 15 and 16 and their dependant claims are not anticipated by Von Kohorn. Therefore Applicant respectfully requests that the rejections of Claims 1-5, 8, 10-15, and 26 under 35 U.S.C. 102(b) as being anticipated Von Kohorn be withdrawn.

III. Claim Rejections Under 35 U.S.C. 103(a)

Claims 6-7, 9, 16-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn in view of Official Notice. Applicant respectfully traverses.

The above arguments that Von Kohorn fails to teach or suggest limitations set forth in Applicants' independent claims are incorporated herein in response to the § 103 rejection and will not be repeated here.

Additionally, Claim 6 requires that the broadcast comprises a display of multimedia content via an internet connection and claim 7 requires that members' responses to subsets of trivia questions be received via an Internet connection. Von Kohorn discloses therein a "numerous central stations, such as television and/or radio stations, may be linked together with a common base station and numerous telephone hubs by a communications system to form a network of broadcast stations." Von Kohorn Col. 7, lines 11-17.

The network thus described is a private network whose components are implemented over a common carrier telecommunication system, not a network connection comprising an Internet connection as claimed. The system described in Von Kohorn is implemented using specialized hardware adapted to communicate using telephone lines, and would require significant reengineering to make use of various Internet connections. In fact, the Internet was already well established at the time of the filing of the Von Kohorn application (1994), and Von Kohorn could have disclosed, or at least suggested, the use of the Internet, but did not.

Regarding claims 16-19 and 20-24, Von Kohorn fails to teach Applicants' claimed step of creating a report indicating of effectiveness of advertising content based at least in part on member's responses to first and second sets of trivia questions relating to advertising content and show content, respectively. While Von Kohorn col. 44, lines 55 to col. 45, lines 1-5, teaches questions directed to televisions advertisements or commercials in order to measure member's recall of the product or services being advertised, nothing in Von Kohorn discloses measuring the effectiveness of advertising based upon members' responses to first and second sets of trivia questions relating to advertising content and show content, respectively. Thus, Von Kohorn, even when combined with the official notice taken by the Examiner, does not teach or suggest the invention of claims 16-19 and 20-24.

Furthermore, as discussed in detail above with respect to the § 102 rejections, Von Kohorn fails to teach or suggest storing in a computer system first and second sets of trivia questions relating to advertising content and show content, respectively, as required by independent claims 16 and 20.

With respect to the obviousness rejection, it has been shown above that claims 6-7, 9, and 16-24 include limitations not taught or suggested by Von Kohorn. It is well established that, in order to show obviousness, all limitations must be taught or suggested by the prior art. In Re Boyka, 180 U.S.P.Q. 580, 490 F.2d 981 (CCPA 1974); MPEP § 2143.03. It is error to ignore specific limitations distinguishing over the references. In Re Boe, 184 U.S.P.Q. 38, 505 F.2d 1297 (CCPA 1974); In Re Saether, 181 U.S.P.Q. 36, 492 F.2d 849 (CCPA 1974); In Re Glass, 176 U.S.P.Q. 489, 472 F.2d 1388 (CCPA 1973). It is therefore requested that the § 103 rejection of claims 6-7, 9, and 16-24 over Von Kohorn be withdrawn.

IV. Conclusion

Having responded to all objections and rejections set forth in the outstanding Office Action, it is submitted that Claims 1-24, 26-31 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, the Examiner is courteously requested to contact applicant's undersigned representative.

The Commissioner is authorized to charge any additional fees associated with this filing, or credit any overpayment, to Deposit Account No. 50-1561. If an extension of time is required, this should be considered a petition therefor.

Respectfully submitted,

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